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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/061,010

02/01/2002

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03/15/2006

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EXAMINER

LAM, ANDREW H

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,010

Applicant(s)

KARN, KEITH S.

Examiner

Andrew H. Lam

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 12/12/05.
- Claims 1-20 are pending in the present application. Claims 1 and 10 are amended. New claims 19 and 20 are added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry (U.S. 2003/0063309) in view of Fujitani et al. (U.S. 2001/0034747) hereinafter Fujitani.

Regarding claim 1, Parry discloses a system (fig. 1, is a system for retrieving email using a printer) comprising a printing-capable device in communication (fig. 1, network 20) with a mail server (fig. 1, email server 16), wherein the printing-capable device has a user interface (fig. 1, LCD display 32, with touch screen).

Parry does not disclose expressly a printing-capable device that accesses an email account which is selected by a user at the user interface, retrieves email headers from the mail server from the user selected email account, receives a user selection of

an email header, retrieves an email message corresponding to a selected email header and print the retrieved email messages.

Fujitani discloses a printing-capable device that accesses an email account which is selected by a user at the user interface (fig. 13, user interface for accessing an email account at the printer stations, page 5, paragraph 49), retrieves email headers from the mail server from the user selected email account (fig. 14, header MR. A, MR. B, MR. C or MR. E, page 5, paragraph 50) to, receives a user selection of an email header (paragraph 50, user touch the email item and the selected header is highlighted), retrieves an email message corresponding to a selected email header and print the retrieved email messages (paragraph 50, selecting a desired e-email to be printed, see fig. 14).

Parry and Fujitani are combinable because they are from a similar field of endeavor of retrieving and printing email via a printing-capable device in communication with a mail server.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the retrieves of email header selected by a user at the user interface of the printing-capable device as taught by Fujitani with the retrieve of email from a mail server.

The motivation for doing so would have been to allow the user to see which headers, i.e., who the message is from, thereby allowing a user at the user interface of the printing-capable device to select only the desired email message to retrieve from the mail server and have it printed at the printing-capable device (Fujitani, paragraph 50).

Regarding claim 2, the combination discloses the system of claim 1 wherein the printing-capable device is a multi-function device (Parry, page 3, paragraph 0024, e-mail enable printer 22 may be a photographic printer--a photographic printer is a multi-function device because it is capable of copying and printing).

Regarding claim 3, the combination discloses the system of claim 1 wherein the printing-capable device is a printer (Parry, page 3, paragraph 0024, e-mail enable printer 22 may be a laser printer).

Regarding claim 4, the combination discloses the system of claim 1 wherein the printing-capable device is a copier (Parry, page 3, paragraph 0024, e-mail enable printer 22 may be a photographic printer--a photographic printer is a multi-function device because it is capable of copying and printing).

Regarding claim 5, the combination discloses the system of claim 1 wherein the network is a local area network (Parry, page 2, paragraph 0022, communication link 26 may be a LAN, see fig. 1).

Regarding claim 6, the combination discloses the system of claim 1 wherein the network is a local area network (Parry, page 2, paragraph 0022, communication link 26 may be a LAN, see fig. 1).

Regarding claim 7, the combination discloses the system of claim 1 wherein the network is a wide area network (Parry, page 2, paragraph 0022, communication link 26 may be a WAN, see fig. 1).

Regarding claim 8, the combination discloses the system of claim 1 wherein the network is at least one of an intranet or the Internet (Parry, page 2, paragraph 0022, communication link 26 may be a internet connection, see fig. 1).

Regarding claim 9, the combination discloses wherein the printing-capable device retrieves an attachment associated with the retrieved email message and prints the retrieved attachment (Fujitani, page 5, paragraph 50, attachment is included with email from MR. C, see fig. 14).

Regarding claim 19, the combination discloses the system of claim 1 further comprising authenticating the access to the user selected email account before allowing the retrieval of the email headers (Fujitani, page 7, paragraph 64).

Regarding claims 10-18 and 20, they are interpreted and thus rejected for the reasons set forth above in the rejection of claims 1-9 and 19 since claims 10-18 and 20 discloses a method that corresponds to the system of claims 1-9 and 19, thus the method is inherent in that it simply provides functionality for the structural implementation found in apparatus claims 1-9 and 19.

Response to Arguments

Applicant's arguments, see pages 4-6, filed 12/12/05, with respect to the rejection(s) of claims 1-18 under 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references due to newly amended limitations as cited in claims 1 and 10.

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Regarding claims 1 and 10, the applicant argued the cited prior art (U.S. 2003/0063309 to Parry) fail to teach and or/ suggest that "the printing-capable device has a user interface and accesses an email account which is selected by a user at the user interface, retrieve email headers from the mail server from the user selected email account".

In response to applicant's argument Fujitani discloses a printing-capable device that accesses an email account which is selected by a user at the user interface (fig. 13, user interface for accessing an email account at the printer stations, page 5, paragraph 49), retrieves email headers from the mail server from the user selected email account (fig. 14, header MR. A, MR. B, MR. C or MR. E, page 5, paragraph 50) to, receives a user selection of an email header (paragraph 50, user touch the email item and the selected header is highlighted), retrieves an email message corresponding to a selected email header and print the retrieved email messages (paragraph 50, selecting a desired e-email to be printed, see fig. 14).

Parry and Fujitani are combinable because they are from a similar field of endeavor of retrieving and printing email via a printing-capable device in communication with a mail server.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the retrieves of email header selected by a user at the user interface of the printing-capable device as taught by Fujitani with the retrieve of email from a mail server.

The motivation for doing so would have been to allow the user to see which headers, i.e., who the message is from, thereby allowing a user at the user interface of the printing-capable device to select only the desired email message to retrieve from the mail server and have it printed at the printing-capable device (Fujitani, paragraph 50).

Contact Information

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew H. Lam whose telephone number is (571) 272-8569. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "KAWilliams". The signature is written in a cursive, flowing style.

**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**